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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,552	12/05/2003	Mark E. Deem	514362000204	4326

7590 04/13/2010
JOHN S. NAGY (FULWIDER, PATTON, LEE & UTECHT, LLP)
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES, CA 90045

EXAMINER

YABUT, DIANE D

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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04/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,552	Applicant(s) DEEM ET AL.	
	Examiner DIANE YABUT	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's pre-brief conference request received on 09/29/2009. Upon further consideration, new grounds of rejection is made below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1-2, 4-12, 31-32, 34-42 are rejected under 35 U.S.C. 102(b) as being anticipated by **Yoon** (U.S. Patent No. **5,542,949**).

Yoon discloses a tissue positioning device **42** having a first opening or port **86** in a first region or jaw **46** for releasably adhering a first area of tissue and an adjacent second opening or port **88** in a second region or jaw **48** for releasably adhering a second area of tissue thereto (Figures 3-4 and 12-13; col. 3, lines 51-55, col. 7, lines 9-24), the first and second openings being separated by a longitudinally positioned septum **223/228** (Figures 16-17; col. 9, lines 25-29 – may be “positioned between parallel pairs of forceps jaws”); a plurality of fasteners or staples **54** housed within the device adapted to be deployed (Figure 2); and wherein the septum being removable from between the first and second openings to allow the at least one fastener to be deployed such that the first area of tissue is secured to the second area of tissue via the fastener (abstract; col. 9, lines 4-29). The tissue positioning device defines a slot (lumen of **42**) within which the septum is positionable. The first area and second area of tissue are adhered to the tissue positioning device via a vacuum created in the first region and the second region which are in fluid communication with a common channel **89** defined within the tissue positioning device that is separated via the septum (col. 7, lines 9-24). The septum is adapted to abrade adjacent tissue using a method consisting of cutting.

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3. Claims 1-12, 31-42 are rejected under 35 U.S.C. 102(e) as being anticipated by **Adams et al.** (U.S. Patent No. **6,585,144**).

Adams et al. disclose a tissue positioning device or stapler device having a first opening or port **19** in a first region (distal region of slot between anvil member **10** and housing **12** in Figures 12-13) and an adjacent second opening or port **34** in a second region (proximal region of slot) both for releasably adhering a respective first area and second area of tissue during deployment of staples, the first and second openings being separated by a septum ("staple retainer") **623** positionable within a slot (Figure 29), a plurality of fasteners or staples housed within the device, and wherein the septum is removable from between the first and second openings to allow the at least one fastener to be deployed such that the first area of tissue is secured to the second area of tissue. A plurality of additional regions for adhering additional tissue (other openings **19** and **34**) are defined in the tissue positioning device. The septum is longitudinally positioned in the tissue positioning device, wherein the longitudinal axis is formed from one end **631** of the septum to the other end **625** of the septum, and also defines a surface **627** that is adapted to abrade adjacent tissue, and may heat tissue as a result of abrading (Figures 27 and 29). The first and second areas of tissue may be adhered to the tissue positioning device via a vacuum created in the first and second regions (in the slot), since Adams et al. disclose utilizing suction through a common channel in fluid communication with the first and second regions an endoscope **8** (Figure 19c; col. 14, lines 56-64), wherein the common channel may be separated via the septum from the distal end of the device.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yoon** (U.S. Patent No. **5,542,949**).

Yoon discloses the tissue positioning device as claimed except for the device defining a plurality of additional openings or ports for adhering additional tissue thereto.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide additional ports or openings to the first and second regions of the tissue positioning device in order to increase the adhering capability of the device to further secure tissue and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Response to Arguments

6. Applicant's arguments with respect to claims 1-12 and 31-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/
Examiner, Art Unit 3734

/Gary Jackson/
Supervisory Patent Trainer
TC 3700
April 11, 2010